

REMARKS

Claims 1-15 are all the claims pending in the application.

At page 3 of the Office Action, claims 1-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoneda (WO99/62482) in view of Noda (JP07-304630).

Applicants traverse and respectfully request the Examiner to reconsider in view of the following remarks.

The Examiner states that Applicants' arguments have been fully considered but have not been found persuasive for three reasons: 1) the Declaration does not clearly establish unexpected results, 2) the Declaration does not demonstrate why one would not [sic] expect separation to occur when the teachings of Noda are applied and 3) Applicants have not demonstrated where it is taught that Noda does not result in a fresh feeling.

Regarding reason 1, the Examiner states that it is unclear as to how the separation of the Yoneda product implies or establishes poor preservation stability since in the Declaration preservation was based solely on changes observed. The Examiner states that "observation" does not provide an objective means of demonstrating stability.

The separation of Yoneda product, based on changes observed, implies and establishes poor preservation stability.

With respect to agents for external skin use, especially cosmetics, the psychological effects (appearance and washability) as well as the pharmacological effects are important aspects of trade value. A cosmetic consumer construes change in color, odor, separation, precipitation and the like as deterioration of the cosmetic. For this reason, stability of the cosmetic, that is, prevention of change in appearance is important. Since a cosmetic is usually filled in a clear container, even a little change in color, separation or precipitation can be easily recognized by

visual observation. Therefore, it is important to maintain the trade value by achieving a cosmetic with optimal storage stability.

With this as a background, the unexpectedly superior results of the presently claimed invention when compared to Yoneda as evidenced in the Declaration are sufficient to overcome the present § 103 rejection. The Declaration demonstrates that the presently claimed invention experienced no change in separation, whereas the Comparative Example using the polyoxyethylene sorbitan fatty acid ester described in Yoneda separated into two layers immediately after preparation of the cosmetics, exhibiting markedly poor preservation stability.

Regarding reason 2, the Examiner states that the rejection is premised on modifying the formulation of Yoneda with Noda, and the Declaration does not clearly establish that one would have also expected a separation when Noda's teachings were applied to Yoneda.

Applicants kindly direct the Examiner's attention to MPEP 716.02(e). In particular, Section III of MPEP 716.02(e) discloses:

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966). (Requiring applicant to compare claimed invention with [subject matter] suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 "would be requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714.).

Accordingly, the Examiner's position that the Declaration should establish what a person having ordinary skill in the art would have expected when Noda's teachings were applied to Yoneda is improper.

Regarding reason 3, the Examiner states that Noda discloses that when polyoxyethylene glycerol fatty acid ester is used, not only does the composition work as a cosmetic but also provides a foaming action that allows for the removal of the makeup in a single step fashion. The Examiner also states that Noda at page 10 discloses excellent feel.

Noda discloses that the effects of the invention can be achieved in the [coexistent] system of polyoxyethylene glycerol fatty acid ester and maltitol ether (maltitol hydroxyl dodecylether) ([0024], claim 1, working examples, etc.). Yoneda does not disclose the use of a maltitol ether. Therefore, a person having ordinary skill in the art would not have been motivated to use the polyoxyethylene glycerol fatty acid ester of Noda as a substitute for the polyoxyethylene sorbitan fatty acid ester of Yoneda with a reasonable expectation of success.

In view of the above, the present invention is patentable over Yoneda. Noda does not remedy the deficiencies of Yoneda. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based on Yoneda in view of Noda.

At page 6 of the Office Action, claims 1-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakai (JP2000-136114) in view of Yoneda.

Applicants traverse and respectfully request the Examiner to reconsider in view of the following remarks.

The Examiner depends on Yoneda for the same reasons set forth in the § 103 rejection based on Yoneda in view of Noda discussed above.

Applicants submit that the present invention is patentable over Yoneda for at least the reasons set forth above with regard to the § 103 rejection based on Yoneda in view of Noda, and

Sakai does not remedy the deficiencies of Yoneda. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based on Sakai in view of Yoneda.

At page 9 of the Office Action, claims 1-6, 8, 10, 12 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ito (JP09-165320) in view of Yoneda.

Applicants traverse and respectfully request the Examiner to reconsider in view of the following remarks.

The Examiner states that Applicants' arguments have been fully considered but have not been found persuasive for reasons like the first two discussed above with regard to the § 103 rejection based on Yoneda in view of Noda discussed above. More specifically, the Examiner indicates that 1) the Declaration does not clearly establish unexpected results and 2) the Declaration does not demonstrate why one would not [sic] expect separation to occur when the teachings of Ito are applied.

Regarding reason 1, the separation of Yoneda product, based on changes observed, implies and establishes poor preservation stability. The unexpectedly superior results of the presently claimed invention when compared to Yoneda as evidenced in the Declaration demonstrate that the presently claimed invention experienced no change in separation, whereas the Comparative Example using the polyoxyethylene sorbitan fatty acid ester described in Yoneda separated into two layers immediately after preparation of the cosmetics, exhibiting markedly poor preservation stability.

Regarding reason 2, the Examiner's position that the Declaration should establish what a person having ordinary skill in the art would have expected when Ito's teachings were applied to Yoneda is improper in view of Section III of MPEP 716.02(e).

In view of the above, the present invention is patentable over Ito, and Yoneda does not remedy the deficiencies of Ito. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based on Ito in view of Yoneda.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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